

Application No. 09/932,520  
Docket No. 1999U021D1.US  
Reply to Office Action Dated May 7, 2004

### Remarks

#### **Claim Amendments**

Claims 8, 9, 11, 12, 14, 35 – 37, 39 and 46 are herein cancelled.

Claim 1 is amended as described above. The added features of the “the onset temperature being greater than 5°C above the polymerization temperature in a polymerization reactor in which the catalyst composition is used, the polymerization temperature being in the range of from 50°C to 120°C” finds support at, for example, page 22, paragraph [085], and further defines the claims which the Applicant contends find support in the specification as filed. The other added claim features find support in the specification as filed, for example, pages 20-21, paragraphs [074] and [076] (“acids”) and [077], [078] (“carbonates and hydroxides”). No new matter is believed to be added.

Claims 56-62 are added:

Claims 56 and 57 are added, the subject matter of which is found in the specification as filed at, for example, pages 20-21, paragraphs [074] and [076] (“acids”) and [077], [078] (“carbonates and hydroxides”).

Claim 58 finds support at page 23, paragraph [090].

The claim limitation in new Claim 59 is derived from page 33, paragraph [145], and other portions of the specification as filed.

The new claims 60 and 61 derived from the Examples and page 24, paragraph [095].

The new claim 62 derives from page 22, paragraph [081].

No new matter is added.

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### Section 112 Rejections

Claims 1, 4-11, 13, 14, 35-37 and 39 stand rejected under 35 U.S.C. 112, first paragraph, as not being enabled. The Applicant traverses this rejection.

The Examiner states in the Advisory Action Dated April 19, 2004 that "claims setting forth physical characteristics of an article without setting forth specific compositions which would meet those characteristics are invalid as vague, indefinite and functional". Given that the Examiner states in Box 3 of the PTOL-303 form that the "bulk of" the Section 112, second paragraph rejections were overcome in the Applicant's response of March 19, 2004, the Applicant takes the above statement to apply to the Section 112, first paragraph rejection in the Office Action dated January 28, 2004.

Claim 1 has now been amended as the Applicant believes is commensurate in scope to the teachings of the specification as filed. In light of the "strong presumption" given to the claims as being enabled (Fed. Reg. Vol. 66, No. 4 (Jan. 5 2001)), the Applicant believes that these amendments place these claims in condition for allowance. In particular, the "applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics". *Fed. Reg.* (2001). The Applicant has done so in the description and examples, and in fact amends Claim 1 to further describe the invention. Further, the chemical nature of the composition itself is further elucidated to a narrower class of compounds as is exemplified by the Applicant.

As for "functionality", the MPEP specifically states that limitations to "functional" features of the invention are allowable. *See, e.g., MPEP* § 2181 (Rev. 1. Feb. 2003). Enablement in this regard is determined by "one skilled in the art". The MPEP states:

If the corresponding structure, material or acts are described in the specification in specific terms . . . and one skilled in the art could identify the structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs are satisfied. *See Atmel*, 198 F.3d. 1382, 53 USPQ2d 1231 (Fed. Cir. 1999).

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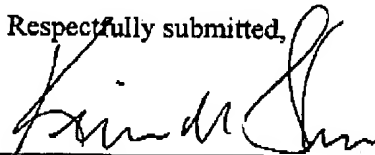
The Applicant contends that the disclosure and working examples as filed would teach one skilled in the art how to practice the invention as now claimed without undue experimentation, and further, that the Applicant was in possession of the invention as claimed as of the filing date. Specifically, one skilled in the art could ascertain, when using an "olefin polymerization catalyst", the "carboxylic acid compound" and "a carbonate or hydroxide compound", in particular, in light of the functional language of "wherein the compounds do not react with each other to form a polymerization catalyst inhibitor below an onset temperature, the onset temperature being greater than 5°C above the polymerization temperature in a polymerization reactor in which the catalyst composition is used, the polymerization temperature being in the range of from 50°C to 120°C". The specification discloses a detailed description of the carbonate and hydroxide compounds, as well as the carboxylic acid compounds and how they are used.

In view of the above it is now respectfully submitted that the claims in this application are in condition for allowance. The Applicant invites the Examiner to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Examiner's satisfaction.

Date

May 7/04

Respectfully submitted,



Kevin M. Faulkner  
Attorney for Applicants  
Registration No. 45,427

Univation Technologies, LLC  
5555 San Felipe, Suite 1950  
Houston, Texas 77056-2723  
Phone: 713-892-3729  
Fax: 713-892-3687